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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,947	09/12/2003	Charles Eric Mowbray	PC25375A	8400
28940 7590 01/25/2007 PFIZER INC 10555 SCIENCE CENTER DRIVE SAN DIEGO, CA 92121			EXAMINER GRAZIER, NYEEMAH	
			ART UNIT 1626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/661,947	Applicant(s) MOWBRAY ET AL.	
	Examiner Nyeemah Grazier	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) 5-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

I. ACTION SUMMARY

The Amendments to the Claims and Remarks submitted to the Office on August 31, 2006 has been fully considered and will be the basis of the following Action.

Claims 1-2, 5-19 are currently pending. Claims 5-9 were originally drawn to compound claims, but have been amended and now recite method of treatment claims. As such claims 5-19 are withdrawn because said claims are drawn to non-elected subject matter.

II. RESPONSE TO AMENDMENTS

A. Claim Rejections – 35 USC 103

Applicant's arguments, see Remarks filed August 31, 2006, with respect to the 103 rejection have been fully considered and are persuasive. The rejection is withdrawn.

B. Claim Objections- Substantial Duplicates

Applicant's argument, see Remarks filed August 31, 2006, with respect to the claim objections have been fully considered. The objection has been obviated in light of the amendments to the claims.

C. Obviousness-type Double Patenting Rejection

Applicant has requested to hold the rejection in abeyance until the current case is allowable. Applicants have not filed a terminal disclaimer to refute the rejection. Thus the rejection is maintained. It should be noted that instant claim 2 is also rejected over co-pending application 11/157,340.

III. REJECTION

Claim 2 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 71-75 of copending Application No.

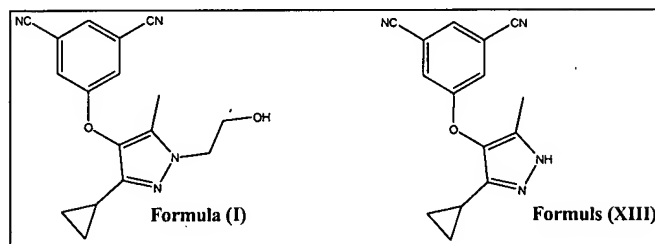
Art Unit: 1626

11/157,340. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). See also M.P.E.P. § 804 (2001).

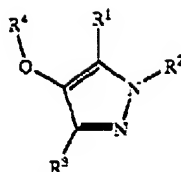
Obvious-type nonstatutory double patenting rejection is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" with the distinction that the double patent rejection is not considered prior art. *Id.* See also *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Thus, the analysis employed in an obviousness-type double patent rejection is consistent with a §103(a) analysis set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 2 recites "[A] pharmaceutical composition comprising the compound according to claim 1 and one or more pharmaceutically acceptable excipients, diluents or carriers."



Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

The co-pending application teaches a the compound and pharmaceutical composition of Formula (I),



wherein R1 is methyl, R2 may represent $-\text{CH}_2\text{CH}_2\text{OH}$ or hydrogen, R3 is cyclopentyl, and R4 is 3,5-dicyanophenyl to afford a compound of Formula (I) of the instant invention.

Ascertainment of the Difference Between the Prior Art and the Claims (MPEP §2141.02)

The single difference between the co-pending application and the instantly claimed inventions is in scope. Both inventions teach the same utility and have the same structural core. The co-pending application is broader in scope than the instant invention. However, the '860 publication teaches a preferred embodiment of the invention which includes the species of the instant invention.

Resolving Level of Ordinary Skill in the Pertinent Art

The pertinent art is immunology. Specifically, the invention is useful in the treatment of Human Immunodeficiency Virus ("HIV"). One of ordinary skill in the pertinent art of immunology would have the motivation to make and use the instant invention because there is motivation to make the instant compounds in the abovementioned references which teach compounds useful for treatment of HIV. The motivation to make the claimed compound derives from the expectation that structurally similar compounds are generally expected to have similar properties and have similar utilities. *In re Gyurik*, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979).

Prima Facie Obviousness-The Rational and Motivation (MPEP §2142-2413)

The motivation to make the claimed compound derives from the expectation that structurally similar compounds are generally expected to have similar properties and have similar utilities. *In re Gyurik*, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979).

There is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application.

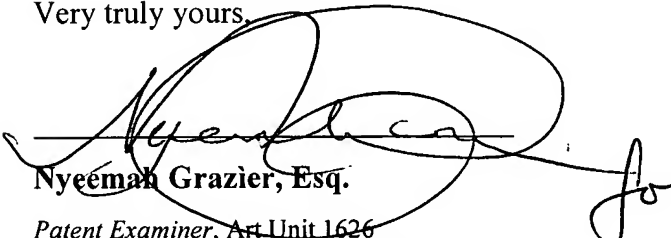
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

IV. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:30 a.m. - 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. M^cKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

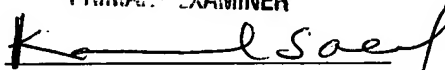
Very truly yours,



Nyeemah Grazier, Esq.

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